

Remarks

Reconsideration of the present application in view of the following remarks is respectfully requested. Applicants gratefully acknowledge Examiner Chang's withdrawal of the previous rejection of claims 13-14 and 29-31 under 35 U.S.C. §112, first paragraph. In the Office Action mailed October 19, 2004, claims 1-7, 9, 10, 13-16, 18, 19, 22 and 23 were rejected.¹

Status of the Claims

Claims 1-7, 9, 10, 13-16, 18, 19, 22, 23, and 29-31 are currently pending in the application. Claim 24 was previously withdrawn subject to a requirement for restriction. (See paper no. 6) No new matter has been added.

Rejections Under 35 U.S.C. §103(a)

Claims 1-7, 9, 10, 15-16, 18, 19, 22, and 23 have been rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Akao (U.S. Pat. No. 4,469,741) in view of Foster (U.S. Pat. No. 5,968,630). Because the Office Action has failed to set forth a prima facie case of obviousness, Applicants request reconsideration and withdrawal of this rejection.

The Office Action states that "Akao is directed to laminated sheets for use as construction materials, particularly floor materials having good cushioning characteristics,"

¹ Although the Office Action Summary shows that claims 29-31 are rejected as well, they are not included or discussed anywhere in the detailed action. Applicants therefore do not address those claims in this response, and respectfully request a notice reflecting allowance of at least claims 29-31.

and acknowledges that the limitation “at least one edge of the second film extends beyond a corresponding edge of the foam sheet” is absent from the disclosure of Akao. (Office Action at pp. 2 and 3.) The Office Action further alleges that Foster describes a “laminate film/foam flooring composite comprising a polyethylene film layer on a polyethylene foam layer, and the laminate is usually in long strips, so when it is installed one edge of one strip overlies the extended portion of the polyethylene film of an adjacent strip.” (Office Action at p. 3.) The Office Action, however, presents absolutely no evidence or argument that a motivation to combine the teachings of Akao with Foster exists, either in the references themselves or otherwise. In fact, the Office Action is unable to present such evidence because Akao offers no suggestion that having at least one edge of the second film extending beyond a corresponding edge of the foam sheet would be necessary or even desirable.

The pending application is directed to, *inter alia*, composite materials that are useful as underlayments for laminate floors. These composites should provide good water vapor barrier properties so that laminate flooring is protected from damage due to exposure to water vapor. (See, e.g., specification at p.1, lines 25-35 and p. 10, line 32 through p. 11, line 10.) By having at least one edge of the second film extending beyond a corresponding edge of the foam sheet, the present invention achieves the desired level of water resistance, making it suitable for use as a flooring underlayment. (Specification at p. 10, line 32 through p. 11, line 10.)

In contrast, Akao describes a laminate composition for use as a wrapping material or construction material, and having strength and/or cushioning characteristics. Akao does not suggest that providing a water vapor barrier is a desired characteristic of the composition described therein, and also does not suggest modifying the laminate by providing an extended

film edge. When considering the Akao reference, therefore, one skilled in the art would have no reason to look to the Foster reference to provide the vapor barrier properties offered by an extended film edge. As a result, the assertion that the Akao and Foster references should be combined is impermissible use of hindsight. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-8 (Fed. Cir. 1998) (“To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.”)

As is clear from MPEP §2143, the Office Action has failed to present a *prima facie* case of obviousness, because motivation to combine or modify the references must be established.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

MPEP §2143. The Office Action has failed to provide any motivation to combine and/or modify the cited references so as to render the present claims obvious. Thus, a *prima facie* case of obviousness has not been established.

Applicants note that the Office Action alleges, with respect to Akao, that “after lamination each of the outer polyolefin film and the low density polyethylene adhesive is believed to form an integral polyolefin film, i.e., the adhesive laminated composite of Akao in view of Foster still reads on the instant invention product as claimed.” (Office Action at p. 4.) Applicants disagree with this characterization of Akao’s disclosure and the composition

described therein. Regardless of the method of attachment of the layers and the composition of the adhesive, however, Akao still lacks any disclosure of a composition having at least one edge of the second film extending beyond a corresponding edge of the foam sheet, and further does not provide a suggestion or motivation to look to Foster to make such a modification.

In view of the foregoing, Applicants respectfully request the reconsideration and withdrawal of the rejections under 35 U.S.C. §103(a).

Withdrawn Claims

Applicants note that claim 24, directed to a method of making the composite structure described in claim 1, remains withdrawn in the present application. Provided that the currently pending claims are found patentable in view of this response, Applicants respectfully request rejoinder of claim 24, as previously suggested by the examiner in paragraph 6 of paper number 6.²

² "It is noted that should the claims of Group I be found allowable, the claims of Group II will be subject to rejoinder pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), wherein claims directed to the process of making or using a patentable product, previously withdrawn from consideration as a result of a restriction requirement, are subject to being rejoined and fully examined for patentability under 37 C.F.R. §1.104"


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Conclusion

In light of the foregoing remarks, Applicants respectfully request withdrawal of all remaining rejections and allowance of the pending claims. Applicants invite the examiner to contact the undersigned at (215) 557-5966 to clarify any issues not resolved by this response.

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